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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/022,501

12/20/2001

Tsuneumi Takahashi

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EXAMINER

MOONEYHAM, JANICE A

ART UNIT

PAPER NUMBER

3629

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
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3 MONTHS

03/02/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/02/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

**Office Action Summary**

Application No.

10/022,501

Applicant(s)

TAKAHASHI, TSUNEFUMI

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 and 8-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

1. This is in response to the applicant's communication received on November 27, 2006, wherein:

Claims 1-5 and 8-14 are currently pending;

Claims 1-3, 5, and 8-14 have been amended.

Claims 6-7 have been cancelled.

***Claim Rejections - 35 USC § 112***

2. Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1-5 and 8-12 are directed to a method and medium for analyzing legal reasoning comprising the following steps:

determining an initial law corresponding to the legislative objective;

receiving an initial image that does not fit in with the initial law via the computer network; and

determining a second law by revising the initial law to remove the potential obstruction;

when the initial image is determined not to obstruct the legislative objective, accepting the initial law as the law; and

when the initial image is determined to obstruct the legislative objective, determining a second law by revising the initial law to remove the potential obstruction caused by the initial image that does not fit in with the initial law.

Claim 5 is directed to receiving a second image that does not fit in with the second law and determining whether the second image obstructs the legislative objective, when the second image is determined not to obstruct the legislative objective, accepting the second law as the law and when the second image is determined to obstruct the legislative objective determining a third law by revising the second law to remove the potential obstruction of the second image that does not fit.

It is not clear how the determination of the initial law corresponding to a legislative objective is performed? Who/what makes this determination? There is not sufficient guidance or direction in the specification as to how this initial law is determined to enable one skilled in the art to which the invention pertains to make or use the invention without undue experimentation.

Who or what determines the initial image that does not fit in with the initial law? What criteria are considered in making this determination? How is a determination made as to whether or not the initial image obstructs the legislative objective? How is a determination made as to whether any of the images obstruct the legislative objective or not?

Claims 13-14 claim determining an objective of the final law, determining an initial law corresponding to the objective, receiving scenarios that potentially obstruct the objective, determining whether each of the scenarios potentially obstruct the

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objective actually obstruct the objective, for each of the scenarios that is determined to actually obstruct the objective, determining a corresponding plurality of revised laws that remove the obstruction and when a scenario is determined not to actually obstruct the objective, identifying a last revised law as the final law. Who or how is the determination of the initial law corresponding to an objective determined? What and who determines whether a scenario obstructs the objective? How are the revised laws that remove an obstruction determined? How is the determination made that there is a final law?

Applicant states on page 10 of the remarks that "an initial image that does not fit in with the initial law" is defined in the specification as "factual scenarios that result in an unacceptable consequence of implementing a proposed law. What and who determines when a consequence is unacceptable?

The Examiner asserts that the applicant has not provided sufficient guidance and direction to one skilled in the art to which the invention pertains to make or use the invention without undue experimentation. Thus, the Examiner asserts that there is a lack of concreteness in the applicant's invention due to the inability of the invention to produce reproducible results. Because the determinations appear to be subjective, for a single situation, there could be different results based on the subjective analysis and determination of each user. Thus, for each individual or group of individuals performing the invention, the result would be different. Therefore, the invention does not produce a repeatable or concrete result as required by statute. The users of the invention must conduct a great deal of experimentation on their part in order to make or use the

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invention, to the point that the users become the inventors of their own application of the invention rather than the applicant.

Thus, the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to use the invention since the subjective analysis and determination does not provide a reproducible, concrete result.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-5 and 8-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant states that an initial/proposed image that does not fit in with the initial law is presented. What is an initial image/proposed image?

In claim 3-4, what defines a nightmare?

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-5 and 8-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. See detailed discussion below.

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35 U.S.C. § 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent: processes, machines, manufactures and compositions of matter.

The applicant's invention is directed to a method, medium and apparatus/system and thus falls within an enumerated statutory class.

However, not all processes, mediums or apparatus/systems are statutory under 35 USC Section 101. To be statutory, a claimed process must either: (A) result in a physical transformation which a practical application is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application which produces a useful, tangible, and concrete result. See *Diehr*, 450 U.S. at 183-84, 209 USPQ at 6. To satisfy section 101 requirements, the claim must be for a practical application of the § 101 judicial exception, which can be identified in various ways:

(a). The claimed invention "transforms" an article or physical object to a different state or thing.

(b) The claimed invention otherwise produces a useful, concrete and tangible result, based on the factors discussed below.

The Examiner must review the claims to determine if the claims provide a practical application that produces a useful, tangible and concrete result. In determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible and concrete, but rather that the final result achieved by the claimed invention is "useful, tangible and concrete."

"Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. "Concreteness" may be evidenced by, but not limited to, repeatability and/or implementation without undue experimentation. "Tangibility" may be evidenced by, but not limited to, a real or actual effect.

The Examiner asserts that the applicant's invention does not produce a "concrete" result. Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same result again. In re Swartz, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000) (where asserted result produced by the claimed invention is "irreproducible" claim should be rejected under section 101). The opposite of "concrete" is unrepeatable or unpredictable. Resolving this question is dependent on the level of skill in the art.

The Examiner asserts that the applicant's invention is not repeatable or predictable. The invention is directed to presenting an objective, determining a law corresponding to the objective, presenting an image/scenario that potentially obstructs the objective and determining a second law by revising the initial law to remove the potential obstruction. The results of the invention cannot be assured since it involves the subjective mental steps of human beings and the result is the subjective analysis and determinations made by these subjective mental steps. The Examiner asserts that the objective mental steps of a human being are not reproducible. The step of presenting an image that does not fit in with the initial law is a subjective mental step. Even using a computer to present the objective and receive the images, the actual



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result of the invention is a presentation of the subjective determination and analysis of the users. The applicant's specification does not disclose how a computer can be programmed, without undue experimentation, to provide a reproducible or predictable result. For each person performing the invention, there would be a different result produced. Thus, there is not reproducible or repeatable result.

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a § 101 judicial exception, in that the process claim must set forth a practical application of that § 101 judicial exception to produce a real-world result. *Benson*, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention ineligible because had "no substantial practical application."). "[A]n application of a law of nature or mathematical formula to a ... process may well be deserving of patent protection." *Diehr*, 450 U.S. at 187, 209 USPQ at 8 (emphasis added); see also *Corning*, 56 U.S. (15 How.) at 268, 14 L.Ed. 683 ("It is for the discovery or invention of some practical method or means of producing a beneficial result or effect, that a patent is granted . . ."). In other words, the opposite meaning of "tangible" is "abstract."

The Examiner asserts that the applicant's claimed invention does not produce a real-world result, or beneficial effect and thus has no substantial application. The invention is directed to a law that is produced by subjective determination and analysis. Therefore, the invention is directed to an abstract idea and the result of the invention is not tangible but also an abstract idea.

The Examiner further asserts that the claimed invention preempts an abstract idea, law of nature, or natural phenomenon (§ 101 Judicial Exceptions). Even when a claim applies a mathematical formula, for example, as part of a seemingly patentable process, the examiner must ensure that it does not in reality "seek[] patent protection for that formula in the abstract." *Diehr*, 450 U.S. at 191, 209 USPQ at 10. "Phenomena of nature, though just discovered, mental processes, abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work." *Benson*, 409 U.S. at 67, 175 USPQ at 675. One may not patent a process that comprises every "substantial practical application" of an abstract idea, because such a patent "in practical effect would be a patent on the [abstract idea] itself." *Benson*, 409 U.S. at 71-72, 175 USPQ at 676; cf. *Diehr*, 450 U.S. at 187, 209 USPQ at 8 (stressing that the patent applicants in that case did "not seek to pre-empt the use of [an] equation," but instead sought only to "foreclose from others the use of that equation in conjunction with all of the other steps in their claimed process"). "To hold otherwise would allow a competent draftsman to evade the recognized limitations on the type of subject matter eligible for patent protection." *Diehr*, 450 U.S. at 192, 209 USPQ at 10. Thus, a claim that recites a computer that solely calculates a mathematical formula (see *Benson*) or a computer disk that solely stores a mathematical formula is not directed to the type of subject matter eligible for patent protection.

The applicant's invention is effectively directed to an abstract intellectual legal concept or process. For applicant to get a patent on an abstract intellectual legal concept or process such as presented in this application, would allow applicant to have

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an patent on the abstract concept of the terms of all legislative processes. Since applicant's recited claims are so broad, applicant's invention, in essence, encompasses every practical application of legal reasoning as directed to our legislative process. Thus, applicant is seeking protection of our legislative process.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 11-12 are rejected under 35 U.S.C. 102(a) as being anticipated by New Hampshire Tax Policy Analysis System (hereinafter referred to as New Hampshire).

Referring to Claim 11:

New Hampshire discloses a system, comprising:

a central processing unit that runs a computer program for the legal reasoning analysis and presents and receives information and determining a percentage (page 3);  
and

a server connected to the central processing unit, the server being accessible by a plurality of user terminals via a packet switched data network (page 7 database system resides on a server machine and supports any number of users).

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Referring to Claim 12:

New Hampshire discloses a memory database connected to the central processing unit for storing data (page 3 databases).

As for the intended use or the data being transmitted by New Hampshire, the Examiner asserts that claims 11-12 are directed to an apparatus. Thus, while features of an apparatus may be recited structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2114). The Examiner has reason to believe that the system of New Hampshire can performed the functional limitations of applicant's claim limitations.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5, 8-10 and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over How Our Laws are Made by Charles W. Johnson (hereinafter referred to as Johnson) in view of New Hampshire Tax Policy Analysis System (hereinafter referred to as New Hampshire).

Referring to Claim 1 and 8-10:

Johnson discloses a method for analyzing legal reasoning for determining a law, comprising:

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presenting a legislative objective of the law ((page (1) the brochure is a basic outline of the numerous steps for our federal lawmaking process from the source of an idea for a legislative proposal; page 3 sources of ideas of legislation are unlimited and proposed drafts of bills originate in many diverse quarters; the work of Congress is initiated by the introduction of a proposal in one of four forms);

determining an initial law corresponding to the legislative objective (page 3 sources of ideas of legislation are unlimited and proposed drafts of bills originate in many diverse quarters; page 4 the work of Congress is initiated by the introduction of a proposal in one of four forms; page 7 any member may introduce a bill at any time);

receiving an initial image that does not fit in with the initial law from at least one of the plurality of participants (page (1) a proposal cannot become a law with consideration and approval; page 10 consideration by committee request for official report of views on the necessity or desirability of enacting the bill into law; page 10 public hearings, committee meetings);

determining whether the initial image obstructs the legislative objective (page 13 reported bills – if the committee votes to report the bill favorably to the House; page 22 Consideration and Debate; page 10 consideration by committee; official report of views on the necessity or desirability of enacting the bill into law);

when the initial image is determined not to obstruct the legislative objection, accepting the initial law as the law (page 1 the fact that a proposal cannot become a law without consideration and approval of both Houses of Congress is an outstanding virtue

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of our bicameral legislative system; page 5 a bill that has been agreed to in identical form by both bodies becomes the law of the land only after Presidential approval); and

when the initial image is determined to obstruct the legislative objective, determining a second law by revising the initial law to remove the potential obstruction caused by the initial image that does not fit in with the initial law (page 24 amendments and the germaneness rule).

Johnson does not disclose a medium or that the process is performed via a computer network. However, New Hampshire discloses a Tax Policy Analysis Computer System (pages 2-3 and 6).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the law making method and medium of Johnson the Analysis System taught in New Hampshire so as to allow state policymakers and analysts to both accurately and quickly determine the effects of both current and proposed State tax policies on new Hampshire residents and to provide a user interface that allows users to recall, store, and edit tax scenarios, submit policy comparisons and view the results of these comparisons.

Referring to Claim 2:

Johnson discloses presenting the second law to the plurality of participants (page 23 second reading –proposed amendment)

Referring to Claim 3:

Johnson discloses wherein determining whether the initial image that does not fit in obstructs the legislative objective comprises:

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receiving votes from the participants on whether the initial image that does not fit in can be agreed upon as a nightmare ((page 22 consideration and debate; page 27-28 Voting).

Referring to Claim 4:

displaying, substantially simultaneously, at least a percentage of the plurality of the participants that agree that the proposed image that does not fit in can be agreed upon as a nightmare (page (1) a proposal cannot become a law with consideration and approval; page 10 consideration by committee request for official report of views on the necessity or desirability of enacting the bill into law; page 10 public hearings, committee meetings).

Referring to Claim 5:

Johnson discloses receiving a second image that does not fit in with the second law from at least one of the participants when the second law has been determined;

determining whether the second image obstructs the legislative objective (page 23 second reading –proposed amendment);

when the second image is determined not to obstruct the legislative objective, accepting the second law as the law (page (1) a proposal cannot become a law with consideration and approval; page 10 consideration by committee request for official report of views on the necessity or desirability of enacting the bill into law; page 10 public hearings, committee meetings); and

when the second image is determined to obstruct the legislative objective, determining a third law by revising the second law to remove the potential obstruction of

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the second image that does not fit in with the second law (the Examiner asserts that this would be a third amendment).

Referring to Claim 13:

Johnson discloses a method for analyzing legal reasoning for deriving a final law, the method comprising:

determining an objective of the final law (page (1) the brochure is a basic outline of the numerous steps for our federal lawmaking process from the source of an idea for a legislative proposal; page 3 sources of ideas of legislation are unlimited and proposed drafts of bills originate in many diverse quarters);

determining an initial law corresponding to the objective (page 3 sources of ideas of legislation are unlimited and proposed drafts of bills originate in many diverse quarters; page 4 the work of Congress is initiated by the introduction of a proposal in one of four forms; page 7 any member may introduce a bill at any time);

consecutively receiving a plurality of scenarios that potentially obstruct the objective (page 22 consideration and debate; (page (1) a proposal cannot become a law with consideration and approval; page 10 consideration by committee request for official report of views on the necessity or desirability of enacting the bill into law; page 10 public hearings, committee meetings)

consecutively determining whether each of the plurality of scenarios that potentially obstructs the objective actually obstructs the objective (page (1) a proposal cannot become a law with consideration and approval; page 10 consideration by



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committee request for official report of views on the necessity or desirability of enacting the bill into law; page 10 public hearings, committee meetings);

for each of the scenarios that is determined to actually obstruct the objective, consecutively determining a corresponding plurality of revised law that remove the obstructions (page 22-24 amendments); and

when a scenario is determined not to actually obstruct the objective, identifying a last revised law of the revised laws as the final law (page 13 reported bills – if the committee votes to report the bill favorably to the House).

Referring to Claim 14:

Johnson discloses receiving voting results regarding whether each on of the scenarios that potentially obstructs actually obstructs the objective (page 27 Voting).

***Response to Arguments***

Applicant's arguments filed November 27, 2006 have been fully considered but they are not persuasive.

As for applicant's argument's as to the rejections under 35 USC 112 1<sup>st</sup> and 2<sup>nd</sup> and 35 USC 101, the Examiner maintains the rejections and directs the applicant to the detailed discussion accompanying the rejections as to the Examiner's position.

As for the applicant's argument that the Examiner did not identify any portion of the New Hampshire Tax Policy System that teaches or suggest presenting an objective of the, receiving an initial law, receiving an image that does not fit, receive votes, etc., the Examiner respectfully disagrees with the assertion. Claims 11-12 are directed to an apparatus. MPEP 2114 states that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. Since the Examiner has reason to believe that the system of New Hampshire is fully capable of transmitting the type of data in the applicant's claims, the Examiner asserts that New Hampshire teaches applicant's claim limitations. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

As for applicant's arguments that Johnson does not describe analyzing a bill in order to obtain a more desirable final law, the Examiner asserts that the debate and amendment process meet this limitation.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Examiner asserts that new Johnson in combination with New Hampshire teach the applicant's invention as set forth in claims 1, 8, and 13. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must **either be in the field of applicant's endeavor or**, if not, then be **reasonably pertinent to the particular problem** with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); \* *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993)>; and *State Contracting & Eng'g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the

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reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved)

See MPEP 2141.01(a) for more.

Furthermore, the Examiner asserts that the legislative process is old and well known process of debating and amending bills as shown by the prior art rejection. As admitted by applicant on page 9 of the Remarks, the applicant states that the initial law is determined by an entity responsible for determining laws, such as a representative group, legislative body or a plurality of participants. The applicant states that the participants (e.g. members of the affected community) provide the images that do not fit in which are received by the entity responsible for determining the laws. The Examiner asserts that each amendment can be considered to be an effort to remove a potential obstruction to a proposal. Furthermore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the brainstorming steps of the legislative process since it has generally been recognized that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ben's Guide to US Government discloses how laws are made starting when a representative has an idea for a new law:

Making laws in Wisconsin discloses the development of proposals to be introduced as bills, wherein there is testimony at which times there can be a vote to recommend passage or defeat or an amendment.

Constitutional Topic: How a Bill Becomes a Law discloses that bills originate from several sources and that the process of making a bill into law is described in the Constitution.

How a Bill Becomes Law discloses that a citizen can see a problem, contact a legislator for solution, a bill gets drafted, the bill is presented and debated in committee, the committee recommends that the bill pass, pass as amended, or not pass, and the bill is voted on.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

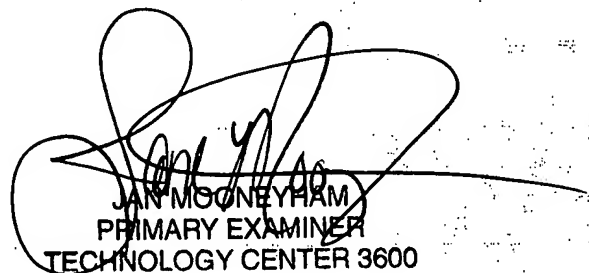
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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